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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/544,094

10/12/2005

Bettina Balslev Sorensen

PATRADE

8613

7590

08/10/2009

James C Wray  
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EXAMINER

QUINN, RICHAE LEE

ART UNIT

PAPER NUMBER

3765

MAIL DATE

DELIVERY MODE

08/10/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/544,094	<b>Applicant(s)</b> SORENSEN, BETTINA BALSLEV	
	<b>Examiner</b> RICHALE L. QUINN	<b>Art Unit</b> 3765	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-11, and 13 - 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-11, and 13 - 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 August 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/6/2009 has been entered. Claims 8 and 12 are cancelled. Claims 15, 16 and 20 are amended. Claims 1- 7, 8-11, and 13 - 22 are currently pending.

***Claim Rejections - 35 USC § 112***

1. Claims 1-7, 9-11, and 13-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 and 9 recite "preferably elastane." It is uncertain if the elastane limitation following "preferably" is a required feature of the claim scope. It is noted that claims 14 and 19 recite the elastane providing further evidence that claims 1 and 9 are indefinite since elastane is recited twice.

2. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat.

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App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 1 and 9 recite the broad recitation between 15 – 60% and the claim also recites between 30 – 50%, which is the narrower statement of the range/limitation.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 – 4, 6, 7, 9 – 11, 13 – 16, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Browder, Jr. (US 6,276,175). The device of Browder, Jr. discloses a clothing article capable of being worn by a person having an ostomy hernia, the clothing article is made for exerting compression (Column 3, lines 35 – 40) and is intended to be disposed around the lower portion of the body, the clothing article is characterized by knitting a seamless tubular (column 2, lines 66 - 67) which is made with an anatomic fit in a predefined size and shape and establishing a firm, elastic (Column 3, lines 26- 28) structure. The device of Browder, Jr. is made on a body size

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circular knitting machine (Column 2, lines 25 -26) and is selectively fixed on the machine form having a predetermined size and shape as the item is being constructed and is sewn together forming a panty brief with a lower body area, groin area and leg openings (Figures 1 and 2) after the garment has been fixated on a form. The extension of the garment is performed with varying intensity (Column 2, lines 30 –34) for establishing varied extension or elasticity and firmness in the article giving varied compression when the clothing article is placed on the body. Elastic yarns are formed along designated courses such that the elastic tension is even throughout the garment and the control area of the garment having spandex makes up approximately 25 – 50% of the garment (Figures 1 and 2).. It is noted that the recitation "for producing compression of between 15 to 5 mmHg" is a functional recitation. The device of Browder, Jr. meets all the structural limitations claimed by applicant and is therefore interpreted to perform in the same manner as the claimed apparatus having a compression of between 15 – 5 mmHg and would have a material that displays a force/elongation curve including a largely flat curve pattern as recited by applicant. The device of Browder, Jr. discloses elastic yarns that are elastane (Column 4, line 5) and the elastic yarn has a thickness of 100 to 350 decitex or 150 - 250 decitex (Column 4, line 5). It is noted that a 140 denier yarn I is the equivalent to a 155.6 decitex yarn.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Browder, Jr. in view of Sinigagliesi (US 2,736,036). The device of Browder, Jr. substantially discloses the claimed invention but is lacking a groin area having an aperture. The device of Sinigagliesi discloses a tubular knit garment having an aperture (13) in the groin area. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the device of Browder, Jr. by utilizing the aperture taught by Sinigagliesi in order to provide access to the genitals from the exterior surface of the garment (column 2, lines 55 – 68).

5. Claims 17, 18, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Browder, Jr. The device of Browder, Jr. substantially discloses the claimed invention but is silent as to the weight per square meter of compression on the user's body. The USPTO office does not have a laboratory to perform testing, and since the device of Browder, Jr. meets all of the structural recitations as claimed by applicant, it is interpreted to perform the function of compression in the same manner as the claimed invention, at a weight per square meter of between 250 and 450g/m<sup>2</sup>. The applicant does not provide criticality in the specification to the specific ranges claimed and therefore the prior art referenced meets the cited limitations.

***Response to Arguments***

6. Applicant's arguments filed 4/6/2009 have been fully considered but they are not persuasive.

7. Applicant submits that the device of Browder teaches away from the claimed invention since Browder discloses that the fiber composition is between 6-10% elastane fibers. Applicant's recited claim language is not claiming that the composition of the fibers is 15 – 60 % but recites that "elastane, are used in part between 15 - 60%, preferably between 30 - 50% of the areas of the clothing article." Applicant's claimed language only requires that the elastane yarn be located in at least 15 – 60% of the surface areas of the garment. The device of Browder discloses elastic yarns that are evenly distributed throughout the garment and therefore interpreted to make up approximately 50%. Moreover, Browder specifically discloses elastic yarn being repeated at least every four course and therefore, elastane is present in at least 25% of the garment.

8. In response to applicant's argument that the garment is intended for a person having a hernia or an ostomy hernia, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

9. Applicant argues that the examiners interpretation of the prior art is not a basis for rejection. The device of Browder, Jr. discloses all of the structural elements claimed by applicant and therefore is interpreted to perform in the same manner. Applicant

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argues that specific compression is not a functional recitation. The compression is a function of the elastic yarns. The elastic yarns of the claimed invention and the prior art are the same and therefore interpreted to perform in the same manner. Applicant has not recited a specific fiber weight or fabric structure which performs the claimed function. When the reference discloses all the limitations of a claim except a property or function, and the examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention but has basis for shifting the burden of proof to applicant as in *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP § § 2112- 2112.02. Applicant merely asserts that the prior art does not perform the function, but has not provided any documentation of proof that the prior art is not capable of performing the claimed function.

10. Applicant argues the combination of Browder and Sinigagliesi. Applicant states that the combination of references is improper because there is no suggestion or incentive to do so. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The devices of Browder and Sinigagliesi are both in the same field of endeavor, a wearing garment, and the device of Sinigagliesi states that motivation for utilizing the aperture is the



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groin is to be able to expose the genitals without removing the garment (column 2, lines 55 – 68).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RICHALE L. QUINN whose telephone number is (571)272-8689. The examiner can normally be reached on M-F 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Welch can be reached on 571-272-4996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Richale L Quinn  
Examiner  
Art Unit 3765

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Examiner, Art Unit 3765

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/KATHERINE MORAN/

Primary Examiner, Art Unit 3765